

### **REMARKS**

Examination is respectfully requested in view of the amendments and the following remarks.

#### **Disposition of Claims**

The claims currently pending in the application are claims 76-87, 98, 99, 104, 108, 110, 114, 115, 118 and 129-150. Claims 123 and 125-128 have been withdrawn in response to a restriction requirement. Claims 129-150 have been added pursuant to the present amendment.

#### **Response to the Restriction Requirement**

Pursuant to a teleconference with the undersigned attorney on January 14, 2005, the Examiner issued a two-way restriction requirement as follows: (1) Group 1 directed to claims 76-86, 98, 99, 104, 108, 110, 114, 115 and 118, and (2) Group 2 directed to claims 123 and 125-128. Applicants elected Group 1 without traverse. However, the Applicants preserve the right to file a divisional patent application covering claims 123 and 125-128 claiming priority from the instant application.

#### **Summary of Pending Prior Art Rejections.**

The Examiner has rejected claims 76, 77, 98, 104, 108, 110, 114 and 118 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,278,499 to Darbee et al. ("Darbee") in view of U.S. Patent No. 5,070,404 to Bullock et al. ("Bullock") and U.S. Patent No. 5,233,423 to Jernigan et al. ("Jernigan"). The Examiner has rejected claims 78-80 under 35 U.S.C. §103(a) as being unpatentable over Darbee, Bullock and Jernigan in view of U.S. Patent No. 5,301,353 to Borrás et al. ("Borrás"). The Examiner has also rejected claims 81, 82, 85 and 115 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,594,493 to Nemirofsky ("Nemirofsky") in view of Bullock. Further, the Examiner has rejected claims 83 and 84 under 35 U.S.C. §103(a) as being unpatentable over Nemirofsky and Bullock in view of Borrás. In addition, the Examiner has rejected claim 86 under 35 U.S.C. §103(a) as being unpatentable over Nemirofsky and Bullock in view of U.S. Patent No. 5,483,276 to Brooks et al. ("Brooks"). Finally, the Examiner has rejected claim 99 under 35 U.S.C. §103(a) as being unpatentable over Darby, Bullock, and Jernigan in view of U.S. Patent No. 4,789,371 to Boggs et al. ("Boggs").

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14

**Applicants' Newly Amended Claims are Not Rendered Obvious by the Darbee Patent in View of the Bullock and Jernigan Patent.**

The Examiner has rejected claims 76, 77, 98, 104, 108, 110, 114 and 118 under 35 U.S.C. §103(a) as being unpatentable by Darbee in view of Bullock and Jernigan. The Examiner has rejected claims 78-80 under 35 U.S.C. §103(a) as being unpatentable over Darbee, Bullock and Jernigan in view of Borrás. The Examiner has rejected claim 99 under 35 U.S.C. §103(a) as being unpatentable over Darby, Bullock, and Jernigan in view of Boggs.

The Examiner asserts that Darbee teaches a hand-held device providing promotional opportunities, with the hand-held device comprising a receiver disposed on the hand-held device for receiving data from a source and a CPU. The Examiner further asserts that Darbee discloses providing a display device for a viewer of an event.

The Examiner contends that Bullock teaches the receiver receives auxiliary data associated with the promotional opportunities of a sponsor being displayed to a user of a television system, wherein received auxiliary data is compared against stored data to trigger promotional opportunities based on the comparison, and providing the benefit of enabling promotional opportunities to users contemporaneously with advertisements.

In addition, the Examiner asserts that Jernigan teaches providing promotional to users which are stored in circuitry, wherein the promotional opportunities are nonrewritable preprogrammed data embedded thereon by a sponsor prior to providing the device to a user, such that the ROM is not subject to tampering.

In response, Applicants have amended independent claim 76 and 98 to overcome Darbee, Bullock and Jernigan. In particular, claims 76 and 98 has been amended to recite the further limitation that central processing unit triggers promotional opportunities for redemption at a point of sale based on the comparison of the auxiliary data against the nonrewritable embedded preprogrammed data. The Applicants aver that no new matter has been added by virtue of this amendment. See page 5 lines 19-20, page 8 lines 6-12 and page 20 lines 19-29. In contrast,

Jernigan teaches encoding and the storing advertisements on a ROM on a television receiver (i.e., a display device) prior to providing the television receiver to the user. See Col 1 lines 51-54 and Col 2 lines 45-47. The preprogramming of an advertiser's message by a manufacturer on a television does not further encourage a viewer of the television receiver to use the television receiver. Rather, Jernigan teaches generating advertisements on the television receiver to be delivered to a purchaser of the television receiver at a reduced cost to the advertiser since the advertiser need not pay for broadcast time to deliver the message. See Col 1 lines 5-34. In addition, Jernigan has no teaching or suggestion to reward users of its television receiver for watching the advertisements, nor does it have disclosure that promotional opportunities may be triggered for redemption at a point of sale. Accordingly, not only would a skilled artisan not be motivated to combine Jernigan with Darbee and Bullock, but the combination of the three references would still fail to teach all of the claimed elements of the present invention.

Based on the foregoing, Darbee, Bullock, and Jernigan do not render obvious independent claims 76 and 98 as now amended and the Examiner is respectfully requested to withdraw his rejection of claims 76 and 98 and indicate the allowance thereof as well as dependent claims 77-80, 99, 104, 108, 110, 114 and 118 based on their respective dependencies to independent claims 76 and 98.

**Applicants' Newly Amended Claims are Not Rendered Obvious by the Nemirofsky Patent in View of the Bullock Patent.**

The Examiner has rejected claims 81, 82, 85 and 115 under 35 U.S.C. §103(a) as being unpatentable over Nemirofsky in view of Bullock. The Examiner has rejected claims 83 and 84 under 35 U.S.C. §103(a) as being unpatentable over Nemirofsky and Bullock in view of Borrás. The Examiner has rejected claim 86 under 35 U.S.C. §103(a) as being unpatentable over Nemirofsky and Bullock in view of Brooks.

The Examiner asserts that Nemirofsky teaches a received disposed on the hand-held for successive reception of auxiliary data from a source at times scheduled by a sponsor during a single video program or a program series, a memory operatively associated with the received and disposed on the hand-held device for storing the auxiliary data and a successive reward data

criteria, wherein the successive reward data criteria requires that a user of the hand-held device capture the auxiliary data at the times scheduled by the sponsor during the signal video program or program series. The Examiner further asserts that Nemirofsky teaches a central processing unit for determining whether the auxiliary data matches the successive reward data criteria.

The Examiner contends that Bullock teaches a plurality of lights in a sequenced array, wherein the array is capable of notifying the user of one or more matches of auxiliary data against preprogrammed data.

In response, the Applicants have amended independent claim 81 to overcome Nemirofsky and Bullock. In particular, claim 81 has been amended to recite the further limitation that the plurality of lights are illuminated upon each match of the successive reception of auxiliary data with the successive reward data criteria to visually indicate on the hand-held device the availability of promotional opportunities of a greater value for redemption. The Applicants aver that no new matter has been added by virtue of this amendment. See page 15 lines 20-27 and page 16 lines 18-28. In contrast, Bullock stores coupons in a particular memory location associated with a category of coupons (i.e., a particular identifier) which are then later enabled by the receipt of an enabling signal. See Col 1 lines 62-66, Col 2 lines 2-6, Col 3 lines 45-50, Col 6 lines 22-25 and Col 6 lines 31-34. The device then illuminates a light for each category of coupon received and enabled so that the coupon from a particular category can be selectively printed as desired. See Col 7 lines 30-34 and Col 7 lines 50-54. There is no suggestion or teaching in Bullock that the successive reception of auxiliary data will result in illumination of lights that reflect a greater value for redemption. In fact, modifying Bullock to teach successive reception of auxiliary data resulting in illumination of lights that reflect a greater value for redemption would require impermissible hindsight as it would require altering design decisions made to implement Bullock to identify and categorize type of coupons during transmission, reception and printing. Accordingly, the claim limitation of illuminating for reflecting a greater value for redemption is not taught or suggested in Bullock.

Based on the foregoing, Nemirofsky and Bullock do not render obvious independent claim 81 as now amended and the Examiner is respectfully requested to withdraw his rejection of

claim 81 and indicate the allowance thereof as well as dependent claims 82, 85, 115, 129 and 130 based on their respective dependencies to independent claim 81.

**Conclusion**

Based on the foregoing, the allowance of claims 76-87, 98, 99, 104, 108, 110, 114, 115, 118, 129-150 is earnestly solicited. Applicants have arranged an interview with the Examiner on April 25, 2004 at 3:00 p.m. in an attempt to resolve any remaining informalities or issues. Applicants are prepared to cooperate as fully as possible to advance the prosecution of this case to allowance.

Respectfully submitted,

4/20/05

Date

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Attachment: Certificate of Fax Transmittal (1 page)  
Response and Amendment Transmittal (2 pages)